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No. 07-527

In the Supreme Court of the United States

WILLIAM DARDEN, PETITIONER

v.

MARYBETH PETERS, REGISTER OF COPYRIGHTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTIONS PRESENTED

Section 410(b) of Title 17 of the United States Code directs the Register of Copyrights (Register) to refuse registration if she determines that the material deposited does not constitute copyrightable subject matter. Section 701(e) makes actions taken by the Register, including refusals of registration, subject to review pursuant to the Administrative Procedure Act (APA), 5 U.S.C. 706(2)(A). The questions presented are:

1. Whether review of the Register's refusal to register petitioner's copyright claims is to be conducted under the APA's abuse-of-discretion standard.

2. Whether the Register acted within her discretion in refusing to register petitioner's claim to copyright in maps of the States of the United States.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-21a) is reported at 488 F.3d 277. The memorandum and order of the district court granting respondent's motion for summary judgment (Pet. App. 22a-34a) is reported at 402 F. Supp. 2d 638.

JURISDICTION

The judgment of the court of appeals was entered on May 24, 2007. A petition for rehearing was denied on July 23, 2007. The petition for certiorari was filed on October 22, 2007 (Monday). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. The Constitution grants Congress the authority "[t]o promote the Progress of Science and useful Arts,

by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. Art. I, § 8, Cl. 8. In the Copyright Act of 1976, Congress has provided for the recognition of copyrights in "original works of authorship." 17 U.S.C. 102(a). Under the statutory scheme, a person who claims a copyrightable work may apply to the Register of Copyrights (Register) to have the work registered. 17 U.S.C. 408(a), 409. Congress has directed the Register to register the work if "after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter," 17 U.S.C. 410(a), and she is to refuse registration if she determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," 17 U.S.C. 410(b). A certificate of registration "constitute[s] prima facie evidence of the validity of the copyright." 17 U.S.C. 410(c). Actions of the Register, with one exception not relevant here, are subject to judicial review pursuant to the Administrative Procedure Act (APA), 5 U.S.C. 701 *et seq.*, 17 U.S.C. 701(e).

2. This is an APA action concerning the Register's refusal to issue a copyright registration for a group of maps showing the States of the United States and, in subsequent state maps, their individual counties (the MAPS work). Petitioner uses those maps on his website so that he can link lists of real estate appraisers to the various locations on the maps. Pet. 4; Pet. App. 2a-3a. Petitioner had the MAPS work created by a contractor who started with public domain digital maps from the United States Census Bureau that depicted the United States, the various States, and the counties within each

State. Pet. 4; Pet. App. 3a. To those Census maps, the contractor added a blue color, shading, and labels (callouts) identifying the States and counties. Pet. 4; Pet. App. 3a. The contractor also smoothed some boundary lines. Pet. 4.

2. Petitioner applied for registration of the MAPS work, as well as the layout of his website, and the Copyright Office refused, asserting that the elements identified by petitioner as having been added to the Census maps were insufficient to meet the requirement for minimally creative expression. Pet. 6; Pet. App. 4a.[1] Petitioner then requested reconsideration from the examiner and subsequently sought review through the Copyright Office's Board of Appeals. At each juncture, the Copyright Office refused registration based on the requirement—set forth in *Feist Publications, Inc.* v. *Rural Telephone Service Co.*, 499 U.S. 340, 341 (1991), and the Copyright Office's regulations—that a work must exhibit minimally creative expression in order to constitute a "work of authorship." The Copyright Office explained that the additions made by petitioner to the Census maps, viewed as a whole, failed to meet the threshold copyright requirement of minimally creative expression. Pet. App. 7a-9a.

3. Petitioner filed this action against the Register in the United States District Court for the Eastern District of North Carolina, pursuant to the APA. On cross-motions for summary judgment, the district court held that the proper standard of review was "abuse of discre-

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[1] Petitioner's application to register copyright in his website layout was also refused. Pet. App. 4a-5a, 20a-21a. That refusal does not appear to be at issue in the petition however, inasmuch as petitioner's only references are to the Copyright Office's grounds for refusal to register the MAPS work.

tion" and rejected petitioner's argument for *de novo* review. Pet. App. 25a-27a. The court then held that the refusal of registration was consistent with the Copyright Office's regulation, 37 C.F.R. 202.1(a), which denies protection for "names, titles, * * * mere variations of typographic ornamentation, lettering or coloring; [or] mere listing of ingredients," as well as with the Copyright Office's *Compendium of Copyright Office Practices II*. Pet. App. 28a-31a. The court held that "[e]ach of the changes to the existing census maps was in the nature of a shading, coloring or font change"—elements that are not protectable under the Copyright Office's regulations. Pet. App. 29a-30a.

4. The court of appeals affirmed. Pet. App. 1a-21a. The court of appeals first rejected petitioner's argument that the district court should have applied the *de novo* standard of review for determining whether agency action is "contrary to a constitutional right, power, privilege, or immunity." Pet. App. 11a (quoting 5 U.S.C. 706(2)(B)). The court noted that, while the Constitution empowers Congress to provide copyright protection, there is no constitutional right to such protection. Pet. App. 12a.

Reviewing the Register's refusal to register the MAPS work under the APA's abuse-of-discretion standard, the court of appeals upheld the Register's determination that petitioner's "contributions to the preexisting maps resemble the list of examples of uncopyrightable works set forth in 37 C.F.R. 202.1(a)." Pet. App. 18a. The court further rejected petitioner's claim that the Copyright Office failed adequately to consider evidence that other persons had recognized the MAPS work in allegedly infringing copies. The court concluded that recognition of a work by third parties, which, by

definition, occurs *after* the work is created, cannot render it copyrightable; a work is either copyrightable subject matter when created, or it is not. *Id.* at 19a-20a.

ARGUMENT

The decision of the court of appeals is correct and does not conflict with any decision of this Court or of any other court of appeals. Further review is therefore unwarranted.

1. Petitioner contends (Pet. 8-13), that the court of appeals erred by failing to treat the Register's denial of registration as the denial of a constitutional right, subject to *de novo* review. The court of appeals correctly held that the denial of registration was subject to review under an abuse-of-discretion standard, and that determination does not warrant this Court's review.

Congress has directed the Register of Copyrights to examine works presented for copyright registration and to refuse registration where "the material deposited does not constitute copyrightable subject matter or * * * the claim is invalid for any other reason." 17 U.S.C. 410(b). Section 701(e) of the Copyright Act makes decisions of the Register generally subject to judicial review under the APA. 17 U.S.C. 701(e); see, *e.g.*, *Atari Games Corp.* v. *Oman*, 888 F.2d 878, 879 & n.1 (D.C. Cir. 1989); *Nova Stylings, Inc.* v. *Ladd*, 695 F.2d 1179, 1182 (9th Cir. 1983). See also Pet. App. 9a & n.2 (noting exception to APA review for decisions of the Register whether to authorize reproduction of articles deposited with the Copyright Office).

Petitioner acknowledges the "line of cases that hold the Office to an abuse of discretion review." Pet. 11. Indeed, every court that has reviewed a refusal of copyright registration in an APA action has applied the fa-

miliar abuse-of-discretion standard to such review, as mandated by 5 U.S.C. 706(2)(A), which governs review of informal agency adjudication. *Atari Games Corp.* v. *Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prod., Inc.* v. *Oman*, 924 F.2d 346, 347-348 (D.C. Cir. 1991); *Atari Games Corp.* v. *Oman*, 888 F.2d at 881; *Coach, Inc.* v. *Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005); *Custom Chrome, Inc.* v. *Ringer*, 35 U.S.P.Q.2d 1714, 1716 (D.D.C. 1995); *Homer Laughlin China Co.* v. *Oman*, 22 U.S.P.Q.2d 1074, 1075 (D.D.C. 1991); *Jon Woods Fashions, Inc.* v. *Curran*, 8 U.S.P.Q.2d 1870, 1871 (S.D.N.Y. 1988).[2]

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[2] In cases where mandamus review of a refusal of registration was sought, prior to the 1976 Copyright Act, the standard for review was also abuse of discretion. *Esquire, Inc.* v. *Ringer*, 591 F.2d 796, 799 n.7, 805-806 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). See also *Bailie* v. *Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958) (upholding decision not to register photograph display and noting Register's discretion in determining what may be registered); *Bouve* v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 53 (D.C. Cir. 1941) (the copyright law "establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept").

Some courts have held that the Register's refusal of registration is also entitled to deference when the issue is presented in the context of an infringement action, at least one that the Register has joined as a defendant. See, *e.g.*, *John Muller & Co., Inc.* v. *New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986); *Norris Indus., Inc.* v. *International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir.), cert. denied, 464 U.S. 818 (1983); but cf. *OddzOn Prods.*, 924 F.2d at 347-350 & n.6 (affording deference to refusal to register on APA review, but indicating that plaintiff could obtain "full judicial review" in infringement action) (quoting *Atari Games*, 888 F.2d at 887 (Silberman, J., concurring)). At least one court has held that the court should make an independent determination on the copyrightability issue in the context of an infringement action where the Copyright Office *had* issued a certificate of registration. See *Carol Barnhart, Inc.* v. *Economy Cover*

Petitioner urges (Pet. 12-13) that a different rule should apply when, as in this case, the application for registration is denied on the ground that the work lacks sufficient originality. Petitioner contends that such suits raise a claim that the agency's action is "contrary to constitutional right, power, privilege or immunity," 5 U.S.C. 706(2)(B), and that *de novo* review must therefore be applied. Petitioner reasons that because the requirement of originality derives from Article I, Section 8, Clause 8, of the Constitution, which empowers Congress to provide copyright protection, denial of a copyright on originality grounds is "contrary to constitutional right" and must be reviewed *de novo*. Pet. 13 (quoting 5 U.S.C. 706(2)(B)).

Contrary to petitioner's contentions, denial of copyright for lack of sufficient originality under the Copyright Act raises no constitutional question. The Constitution authorizes Congress to grant copyright protection, and sets as a minimum requirement that such protection may be afforded only to "original" works. *Feist Publications, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991) ("originality is a constitutionally mandated prerequisite for copyright protection"). The Constitution does not, however, confer a constitutional right to copyright protection for every work that satisfies the constitutional minimum, much less to copyright registration under the Copyright Act or the presumption of validity that registration entails. *Sony Corp. of Amer.* v. *Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984) ("the protection given to copyrights is wholly statu-

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Corp., 773 F.2d 411, 413-414 (2d Cir. 1985). That question is not presented in this action, brought under the APA to challenge the Copyright Office's refusal to register. See Pet. App. 16a; *OddzOn Prods.*, 924 F.2d at 347-350.

tory"); see also *Silvers* v. *Sony Pictures Entertainment, Inc.*, 402 F.3d 881, 883-884 (9th Cir.) (en banc) (copyright protection is "a creature of statute"), cert. denied, 546 U.S. 827 (2005). Cf. *Goldstein* v. *California*, 412 U.S. 546, 559 (1973) (recognizing that Congress could decide whether or not to provide copyright protection for certain works). The court of appeals correctly rejected petitioner's attempt to convert every suit challenging "the agency's routine decision to deny registration" into a constitutional case. Pet. App. 11a. See *id.* at 13a ("Essentially, [petitioner] is claiming that the Register simply reached the wrong result, not that the Register applied the wrong legal standard or misapprehended or ignored the controlling legal principles.").[3]

Petitioner is unable to cite any judicial decision, much less one from this Court or another court of appeals, that adopts petitioner's distinction (Pet. 11-12), for purposes of the standard of review, between refusals of registration involving "useful articles" and refusals based on lack of originality. Several of the decisions cited above upheld, under an abuse-of-discretion standard, the Register's determination that the works at issue lacked sufficient minimal creative expression to constitute original works of authorship entitled to copyright protection. See *Coach*, 386 F. Supp. 2d at 498-499 (interlocking letter pattern); *Homer Laughlin China*, 22 U.S.P.Q.2d at 1076 (GOTHIC china pattern). See also *John Muller & Co., Inc.* v. *New York Arrows Soccer*

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[3] In the analogous field of patents, where Congress's power to confer monopoly rights derives from the same constitutional grant, this Court has recognized that the U.S. Patent and Trademark Office's findings of fact regarding the patentability of an invention are reviewed for substantial evidence in an APA action. *Dickinson* v. *Zurko*, 527 U.S. 150 (1999).

Team, Inc., 802 F.2d 989, 990 (8th Cir. 1986) (holding no abuse of discretion in refusal to register team logo consisting of four lines and cursive word).

Petitioner's contention (Pet. 12-13) that there is a conflict between the decision below and those of the D.C. Circuit in the *Atari* cases is mistaken. As petitioner recognizes (Pet. 12-13), the *Atari* court (per then-Judge Ginsburg) explicitly a plied the deferential abuse-of-discretion standard in reviewing the Register's refusal of registration to the video game "BREAKOUT." 979 F.2d at 243. That the court found an abuse of discretion in that case, holding that the Register failed to account for the sequence of sounds and images (among other elements) appearing in the work, simply confirms that abuse-of-discretion review, while highly deferential, nevertheless constitutes a meaningful review of the agency decision in light of the administrative record. *Id.* at 246-247. Nothing in the court of appeals' decision in the instant case suggests otherwise.

2. Examining the undisputed facts of this case, and the Copyright Office's rationale (as set forth in increasing detail in its decisions during its own appeal procedures), the court of appeals correctly upheld the Register's determination that the MAPS work is not sufficiently original to qualify as copyrightable.

Petitioner admittedly produced MAPS by starting with Census maps containing the outlines of the various States and counties. Pet. 4. To those Census maps, petitioner added blue coloring, labels for geographic placenames (referred to as callouts), and smoothed borders. See Pet. 15; Pet. App. 3a. The Copyright Office's regulations, 37 C.F.R. 202.1(a), list "mere variations of typographic ornamentation, lettering or coloring" as elements that are not considered minimally creative. See

Pet. App. 17a. The court of appeals correctly held, in light of the regulation and the limited changes made by petitioner to the preexisting Census maps, that the Register had acted within her discretion in refusing to register the MAPS work. *Id.* at 18a-20a.

Petitioner's contention (Pet. 13-18) that the court of appeals' decision is in conflict with this Court's opinion in *Feist* and the D.C. Circuit's decision in *Atari* is mistaken. In *Feist*, this Court recognized that a work must contain some minimum amount of creative expression to qualify for copyright, and that trivial or typical elements do not meet the originality requirement. 499 U.S. at 345. In that case, the Court held that "[t]he selection, coordination, and arrangement of [the respondent's] white pages do not satisfy the minimum constitutional standards for copyright protection." *Id.* at 362. The Register's conclusion that the MAPS work lacked sufficient originality to satisfy the statutory and regulatory requirements for registration in no way conflicts with the holding in *Feist*.

While maps are eligible for copyright protection, the court of appeals correctly recognized that not all maps—particularly those derived from public domain maps—are copyrightable. Pet. App. 18a-19a. Here, the aspects added by petitioner to the public domain maps consisted of coloring, labels, and smoothed lines. Those are the very elements that are identified in the Copyright Office's regulation, 37 C.F.R. 202.1(a), as lacking sufficient creative expression to establish a basis for copyright protection. Other courts of appeals have, like the court below, recognized Section 202.1(a) as a reasonable interpretation of copyright law and accorded it deference. See, *e.g.*, *ATC Distribution Group, Inc.* v. *Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700,

709-710 (6th Cir. 2005); *Southco, Inc.* v. *Kanebridge Corp.*, 390 F.3d 276, 285-287 & n.5 (3d Cir. 2004) (en banc) (specifically according deference to section 202.1(a) as reflecting the "body of experience and informed judgment" of the agency) (citation omitted); *CMM Cable Rep., Inc.* v. *Ocean Coast Props., Inc.*, 97 F.3d 1504, 1519-1520 & n.21 (1st Cir. 1996) (noting that regulation is a fair summary of the law). The decision below accords with those holdings of other circuits.

Neither is there any conflict with *Atari*. In *Atari*, the D.C. Circuit reviewed the refusal of registration for abuse of discretion, but held that the Register had failed to account for the sequence of graphical screens and accompanying sounds that comprised the BREAKOUT video game. 979 F.2d at 245-247. Thus, the refusal of registration was held to be an abuse of discretion because it lacked a rational basis. *Id.* at 247. Here, the Copyright Office explained, in increasing detail through its internal appeal process, why the coloring, labeling, and line smoothing added by petitioner was insufficient, taken as a whole, to meet the minimal creativity requirement. Pet. App. 6a-9a, 18a. The Copyright Office's judgment represents a reasonable application of the *Feist* principle requiring some minimal creativity to the MAPS work, in light of the Copyright Office's longstanding regulations. See *Coach*, 386 F. Supp. 2d at 498-499.

Finally, the court of appeals properly rejected petitioner's argument (Pet. 18-20) that alleged confusion between its MAPS work and copies displayed by competitors conclusively demonstrated an abuse of discretion because it showed that the MAPS work was unique. The court of appeals correctly recognized that alleged source identification is not part of the test for copyrightability, because, by definition, source identifi-

cation could not exist at the time of the work's creation. See Pet. App. 19a ("a work is copyrightable at the time of its creation or not at all"); *Coach*, 386 F. Supp. 2d at 499 (rejecting similar argument regarding "C" logo). Just as a single letter, such as a "C," or a single color, such as the pink color of a brand of insulation, might be recognized as a source indicator, and might, in appropriate circumstances, be afforded trademark protection, according copyright protection to such attributes would vitiate the Copyright Office's longstanding regulation and interpretation of copyright law as forbidding copyright protection for a letter or a color.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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